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KIMBERLY-CLARK WORLDWIDE, INC. Tara Pohlkotte 2300 Winchester Rd. NEENAH, WI 54956			HAND, MELANIE JO	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERESA M. ZANDER, KRISTI JO BRYANT,
DEBRA A. HAASE, SHEILA M. HEYRMAN, KIM HOERTSCH,
ADRIENNE R. LOYD, WILLIAM G. REEVES, GARRY R. WOLTMAN,
and THEODORE T. TOWER

Appeal 2009-011688
Application 10/749,871
Technology Center 3700

Before: WILLIAM F. PATE III, KEN B. BARRETT, and
CHARLES N. GREENHUT, *Administrative Patent Judges.*

GREENHUT, *Administrative Patent Judge.*

DECISION ON APPEAL

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STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1, 3-18 and 20-24. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm and denominate this affirmance as containing new grounds of rejection.

The claims are directed to a visually coordinated absorbent product.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A visually coordinated absorbent product comprising:

a product component comprising a body side liner, a garment side outer cover and an absorbent core disposed between said body side liner and said garment side outer cover, wherein said product component has at least a first and second visual characteristic, wherein said first visual characteristic is different than said second visual characteristic, wherein said product component comprises a peel strip removably connected to said garment side outer cover over a garment attachment adhesive, wherein at least a portion of said garment side outer cover is configured with said first visual characteristic and at least a portion of said peel strip is configured with said second visual characteristic; and

a packaging component having at least said first and second visual characteristics, wherein said product component is disposed in said packaging component.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Deflander	US 5,531,325	Jul. 2, 1996
Mosley	US 5,752,945	May 19, 1998
DiPalma	US 6,264,776 B1	Jul. 24, 2001
Kuske	US 6,318,555 B1	Nov. 20, 2001
Batra	US 6,520,330 B1	Feb. 18, 2003
Molina	US 6,601,705 B2	Aug. 5, 2003

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Kudo	US 6,802,833 B2	Oct. 12, 2004
Briseboi	US 2002/0148749 A1	Oct. 17, 2002
Farris	WO 2002/30347 A1	Apr. 18, 2002

REJECTIONS

Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Briseboi. Ans. 4.

Claims 14, 18, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Briseboi and Batra. Ans. 5.

Claims 16, 17 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Briseboi, Batra, and Kudo. Ans. 7.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Molina, Batra, and Briseboi. Ans. 9.

Claims 16, 17, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Molina, Batra, and Kudo. Ans. 11.

Claims 1, 3-13, 15, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Molina, Batra, and Farris. Ans. 11.

OPINION

We affirm the Examiner's rejections of claims 1, 3-18 and 20, 21, 23, and 24. However, since our claim construction and rationale differs from that of the Examiner, pursuant to our authority under 37 C.F.R. § 41.50(b), we denominate this affirmation a new grounds of rejection in order to afford Appellants a fair opportunity to respond.

Appellants acknowledge that the claimed absorbent product, individual wrapper or pouch, and bag or box, each themselves having a visual characteristic such as color, were known in the art at the time of invention. *See Spec. 1:6-19, 6:1-6 (citing U.S. Patent 6,315,765).*

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Appellants' arguments are predominantly concerned with the "visual characteristics" of the claimed absorbent product.

Appellants and the Examiner have not recognized the applicability of the so-called printed matter doctrine to the claims on appeal. The claim term "visual characteristic" is expressly defined in the Specification as "a feature or characteristic that is discernible by sight during the normal use of the component, and includes for example and without limitation color, shape, embossing, patterns (e.g. by printing), sealing patterns, etc." Spec. 12:12-15. The claimed "visual characteristics" fall squarely within the printed matter doctrine. As such, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *See In re Gulack*, 703 F.2d 1381, 1384 (Fed. Cir. 1983). In the event that the printed matter is not functionally related to the substrate, the printed matter may not be entitled to patentable weight in evaluating the claimed subject matter under § 102 or § 103. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

The purposes of the visual characteristics are to provide the user "with an impression that the product is of high quality, and that the product and packaging were designed together, rather than piece meal," to provide the user "with an emotional benefit, allowing them to feel more feminine with respect to female absorbent products, and to feel better about the product they are using", and to "identify the product for the user, for example provide source identification." Spec. 3:5-13.

Providing a user with the impression that the product is of high quality and providing source identification amount to merely informing a user about inherent characteristics of a known product. These functions of the visual characteristics could be achieved without the visual characteristics being

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placed on the product, its packaging, or any specific portions thereof. Similarly, the claimed absorbent product does not require the visual characteristics in order to convey this information to a user. Thus, the visual characteristics in no way depend on the absorbent product and the absorbent product in no way depends upon the visual characteristics. *See In re Ngai*, 367 F.3d at 1339. Providing “visual characteristics” on a known product to inform a user about the quality or origin of that product in no way transforms the product itself. Irrespective of whether a user is informed about the quality or origin of a product, the actual product is the same. *See e.g., King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1278 (Fed. Cir. 2010) (An otherwise anticipated method claim does not become patentable because it includes the step of “informing” someone about the existence of an inherent property of a drug used in that method, or because it includes a container having printed labeling to convey that same information.).

Providing an “emotional benefit” is highly dependent upon the mind of the user. The emotion elicited is the same thing that distinguishes different words, pictures, sounds or colors conveyed via the same substrate. Once again, this result could be achieved regardless of the relationship between the absorbent product and the visual characteristics. Thus, providing an emotional benefit does not create a functional relationship between the visual characteristics and the absorbent product.

For these reasons, we conclude that the recited “visual characteristics” are not functionally related to the product, its packaging, or any specific portions thereof. Therefore, we find Appellants’ arguments, that the “visual characteristics” patentably distinguish the claimed subject matter from the prior art, unpersuasive.

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When no patentable weight is afforded the visual characteristics, claims 14, 18, 20, and 21 are anticipated by Briseboi and claims 1, 3-13, 15, and 24 are anticipated by Molina. Therefore the subject matter of these claims is rendered obvious by Briseboi or Molina, respectively, in combination with the other prior art. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (anticipation is the ultimate of obviousness).

Even were we to find that the visual characteristics were functionally related to their respective substrates, the limitations requiring first and second visual characteristics would be met by providing a two-color trade dress on both product and packaging. This modification amounts to applying a known technique of using a two-color trade dress on a product and its package to a known absorbent product in order to yield the predictable result of identifying the source of the absorbent product based upon the color of the product and/or packaging and therefore would have been obvious to one having ordinary skill in the art. Selecting a particular location for the colors amounts to choosing from a finite number of predictable solutions – any part of the product or packaging components – and therefore, also would have been obvious to one having ordinary skill in the art.

We are mindful of the fact that the Examiner construes independent claims 1, 5, 14, 16 and 18 to require a first and second visual characteristic and cites Batra's "indicia" for this teaching. Ans. 5-11. Batra is directed to solving a problem similar to the one identified by Appellants—providing a common theme between packaging and product. Batra, col. 1, ll. 29-35; Spec. 1:19-23. However, Batra provides matched, but non-identical indicia on the product and package. Col. 1, ll. 54-62. If weight is afforded to the "visual characteristics" recited in the claims, independent claims 1, 5, 14, and 16 require first and second different visual characteristics on a product

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and those *same* characteristics on a packaging component since the claim recites “*said* first and second visual characteristics.” App. Br. 13 (emphasis added).

While Batra’s indicia 15 themselves may be different on product and package, Batra does demonstrate examples of duplicating multiple elements of the indicia (e.g., 18, 22, 24) on both product and package. Batra, figs. 3A-3C. As noted above, the recited “visual characteristic” may simply be a shape. Batra teaches disposing latticeworks 18 which “may resemble a matrix or a gridwork of diamonds, squares, circles or any other polygon or irregular shape” containing cells 22 on both a consumer product and its package. Col. 5, ll. 31-43; figs. 2A-B. Batra also teaches that decorative markings 24 may be disposed in the cells 22 of both latticeworks 18. Col. 5, ll. 49-51. Although Batra’s overall indicia 15 may not be the same, Batra demonstrates that it was known in the art to provide components of that indicia, including the latticework 18, cells 22 and decorative markings 24, on a product and its outer and inner packaging. *See* col. 8, ll. 50-63. Each of these components is reasonably read as the recited “visual characteristic.”

Turning to Appellants’ arguments regarding claims 16, 17 and 23, we agree with the Examiner that Kudo demonstrates that employing spunbond material in packaging 15 was known in the art. Kudo, col. 7, ll. 20-27. We also agree that incorporating such a material into the devices of either Briseboi or Molina amounts to the simple substitution of known elements in order to yield predictable results and would have been obvious to one having ordinary skill in the art. Ans. 7-8. Appellants’ argument that using a low basis weight spunbond or see-through material would render portions of Briseboi’s or Molina’s invention obsolete (App. Br. 22-24) is premised upon making the entire package from such a material. This is not required to

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arrive at the claimed structure. Since Appellants have not established that Briseboi or Molina criticizes or discredits such a material, Appellants have not established that Briseboi or Molina teaches away from it. *See App.* Br. 22, 23; *See also In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

We affirm the Examiner's rejection of claim 22 as being unpatentable over Briseboi. However, since our claim construction and rationale differs from that of the Examiner, pursuant to our authority under 37 C.F.R. § 41.50(b), we denominate this affirmation a new grounds of rejection in order to afford Appellants a fair opportunity to respond.

Appellants do not dispute that Briseboi discloses the basic absorbent product of the claim 22. App. Br. 25, 26; Briseboi p. 4, para. [0043], p. 3, paras. [0032]-[0033], p. 4 paras. [0045]-[0046], figs. 2, 3, 7. Rather, Appellants contend that in the Figure 7 embodiment of Briseboi "both indicia are on the reminder tag, not on the wrapper. In essence, Briseboi teaches indicia 106 and 108 as being both on the wrapper or both on the fastening element, but not one on each!" The Examiner found this argument persuasive, withdrew the rejection under 35 U.S.C. § 102, and entered a new ground of rejection for claim 22 under 35 U.S.C. § 103(a). Ans. 4, 14, 19.

Regarding the Examiner's rejection of claim 22 under 35 U.S.C. § 103(a), we agree with Appellants that separating the pointer 108 from the scale 106 would not have been obvious to one of ordinary skill in the art because doing so would be counterproductive to Briseboi's intention of "allow[ing] the user to quickly ascertain a characteristic of the sanitary absorbent article." P. 1, para. [0001]. *See Reply Br. of Dec. 17 2007*, pp. 3-4. However, unlike the Examiner, we are not persuaded by Appellants' argument regarding the location of the recited "visual characteristics."

As discussed above, the recited “visual characteristics” are not functionally related to the product, its packaging, or any specific portions thereof. Therefore, we find Appellants’ arguments that the “visual characteristics” patentably distinguish the claimed subject matter from the prior art unpersuasive. When no patentable weight is afforded the visual characteristics, claim 22 is anticipated by Briseboi. However, even were we to afford weight to the “visual characteristics,” Briseboi would still anticipate claim 22.

Regarding the embodiment depicted in Figure 7, Briseboi discloses that the visual reference system 704 is realized on a substrate 722 that is adhesively attached to the pouch 310, extending partly on the flap 101, read as the claimed “wrapper” and partly on the envelope-like enclosing structure 99, read as the claimed “fastening element.” P. 4, para. [0045]. The presence of a single substrate 722 does not change the fact that at least a portion of the reference scale 106, including an icon, read as the claimed “visual characteristic” is affixed to flap 101 while the pointer icon 108 is affixed to the envelope-like enclosing structure 99. It is therefore reasonable to interpret enclosing structure 99 and flap 101 as having first and second visual characteristics, respectively..

DECISION

The Examiner’s rejections of claims 1, 3-18 and 20-24 are affirmed. However, since our claim construction and rationale differs from that of the Examiner, pursuant to our authority under 37 C.F.R. § 41.50(b), we denominate this affirmance as containing new grounds of rejection in order to afford Appellants a fair opportunity to respond.

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37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)

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